

## REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-3 have been canceled.

New claims 13-21 have been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 4-21 are now pending in this application. Claims 4-12 have been withdrawn from consideration.

### Rejections under 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,676,913 to Cirillo *et al.* (hereafter “Cirillo”) and as being anticipated by U.S. Patent No. 5,221,520 to Cornwell (hereafter “Cornwell”). Claims 1-3 have been canceled. Accordingly, the outstanding § 102 rejections are now moot.

### New Claims

New claims 13-21 have been added. Claims 13 and 20 recite methods of oxidizing carbon monoxide that include the steps of, among other things, decomposing generated ozone by use of an ozone decomposing member, adsorbing and carrying carbon monoxide by use of a CO adsorbing member, wherein the ozone decomposing member is made of a substance selected from the groups recited in claims 13 and 20 and is in “the form of a honeycomb structure or a three dimensional mesh structure,” and wherein the CO adsorbing member is composed of “fine particles” made from at least one platinum based precious metal selected from the groups recited in claims 13 and 20.

The outstanding § 102 rejections do not apply to these newly added claims because neither Cirillo nor Cornwell disclose an ozone decomposing member that is in “the form of a honeycomb structure or a three dimensional mesh structure,” and a CO adsorbing member

that is composed of “fine particles,” as recited in claims 13 and 20. Claims 14-19 depend from claim 13 and claim 21 depends from claim 20.

Furthermore, Cirillo does not disclose a CO adsorbing member that made from the materials recited in claims 13 and 20. Cirillo discloses catalyst that can include a mixture of catalysts, such as NiO, CuO, MnO<sub>2</sub>, and Pt. See Cirillo at col. 4, lines 11-29. The Office notes on page 4 of the Office Action that Applicant’s disclosure notes that an oxide of Mn can be an ozone decomposing substance and that Pt can be a CO adsorbing member. However, Cirillo does not provide any express teaching that the catalyst disclosed by Cirillo acts as a CO adsorbing member. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally M.P.E.P. § 2131.

Nor would it be inherent that the catalyst of Cirillo would act as a CO adsorbing member. Any inherent disclosure in Cirillo may not be established by probabilities or possibilities. See M.P.E.P. § 2112, Part IV, *citing In re Robertson*, 49 USPQ2d 1949, 1950-51, (Fed. Cir. 1999). To rely upon inherency, a basis in fact and/or technical reasoning to reasonably support the determination that an allegedly inherent characteristic necessarily flows from the disclosure of the prior art must be provided. See M.P.E.P. § 2112, Part IV, *citing Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office has not provided a basis in fact and/or technical reasoning that reasonably supports a determination that the catalyst of Cirillo inherently acts as a CO adsorbing member, as recited in claims 13 and 20. Therefore, Cirillo does not anticipate, either expressly or inherently, all of the features of claims 13 and 20.

Cornwall discloses an apparatus for treating air with a catalyst that includes metal oxides, such as MnO<sub>2</sub>. See Cornwall at col. 10, lines 11-23. However, Cornwall does not disclose a CO adsorbing member that is made from at least one platinum based precious metal, as recited in claims 13 and 20.

Therefore, Cirillo and Cornwall do not anticipate claims 13 and 20 because Cirillo and Cornwall does not disclose, either explicitly or implicitly, all of the features of these claims.

### CONCLUSION

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By P.D.S.

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